

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN**

MOTOROLA MOBILITY, INC., and
GENERAL INSTRUMENT
CORPORATION,

Plaintiffs,

vs.

MICROSOFT CORPORATION,

Defendant.

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) Civil Action No. 10-cv-700
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) District Judge William M. Conley
) Magistrate Judge Stephen L. Crocker
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STIPULATION TO STAY CASE

Plaintiffs Motorola Mobility Inc. and General Instrument Corporation ("Plaintiffs") and Defendant Microsoft Corporation ("Defendant") (collectively "the Parties"), by and through their respective counsel of record, hereby stipulate and agree as follows:

1. The Parties stipulate that Plaintiffs may file a Second Amended Complaint and that, if not filed prior to the Court's Order on this stipulation, shall be deemed filed and accepted as of the entry of the Court's Order on this stipulation. (*See* Docket No. 26.) The Second Amended Complaint, to be filed by Plaintiffs this week, no longer asserts U.S. Patent No. 6,686,931.

2. Pursuant to 28 U.S.C. § 1659 and the Court's inherent power to control its Docket, the Parties stipulate to a stay of proceedings in the above-captioned matter pending a final determination of the United States International Trade Commission ("ITC") in *In the Matter of Certain Gaming and Entertaining Consoles, Related Software, and Components thereof*, Investigation No. 377-TA-752. This stay applies to all remaining claims asserted by Plaintiffs in their Second Amended Complaint, including all claims relating to U.S. Patent No. 5,311,516.

3. Defendant agrees that it will not raise Plaintiffs' agreement to stay claims relating to U.S. Patent No. 5,311,516 in any subsequent Court filing or communication with the Court.

4. Plaintiffs filed a Complaint in this matter on November 10, 2010, alleging that Microsoft infringes seven patents: U.S. Patent Nos. 5,319,712; 5,357,571; 6,069,896; 6,980,596; 7,162,094; 5,311,516; and 6,686,931. Five of those patents (U.S. Patent Nos. 5,319,712; 5,357,571; 6,069,896; 6,980,596; 7,162,094) also are being asserted in the ITC proceeding. Plaintiffs now seek to drop claims relating to U.S. Patent No. 6,686,931 from this case and to instead assert that patent in case No. 10-cv-826, also pending in this District.

5. On November 22, 2010, Plaintiffs filed a First Amended Complaint.

6. On December 21, 2010, Defendant filed a motion to dismiss the First Amended Complaint pursuant to Rule 12(b)(6).

7. On December 21, 2010 Defendant also filed a motion to dismiss, stay, or in the alternative, transfer this case to the Western District of Washington.

8. On January 11, 2011, Plaintiffs filed a motion for leave to file a Second Amended Complaint.

9. 28 U.S.C. § 1659(a) provides that “[i]n a civil action involving parties that are also parties to a proceeding before the [ITC] under section 337 of the Tariff Act of 1930, at the request of a party to the civil action that is also a respondent in the proceeding before the Commission, the district court *shall stay*, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the commission,” so long as “such request is made within (1) 30 days after the party is named as a respondent in the proceeding before the Commission, or (2) 30 days after the district court action is filed, whichever is later.” 28 U.S.C. § 1659(a) (emphasis

added). The Parties to the above-captioned civil action are also the Complainants and Respondent in the ITC proceeding involving the same issues involved here—the putative infringement of Plaintiffs' five patents identified in Paragraph 4, above.

10. The requested stipulation is timely. The 30-day period under 28 U.S.C. § 1659(a)(1) did not begin to run until December 17, 2010—the day Defendant was named as respondent in the proceeding before the ITC.

11. Accordingly, the Parties respectfully request that the Court enter an Order directing that:

A. Pursuant to 28 U.S.C. § 1659 and the Court's inherent power to control its Docket, all proceedings in the above-captioned matter, including proceedings on Defendant's December 21, 2010 motion to dismiss, stay, or transfer, are hereby stayed pending a final determination of the United States International Trade Commission ("ITC") in *In the Matter of Certain Gaming and Entertaining Consoles, Related Software, and Components thereof*, Investigation No. 377-TA-752. This stay applies to all remaining claims asserted by Plaintiffs after filing of the Second Amended Complaint, including all claims relating to U.S. Patent No. 5,311,516;

B. The deadline for Defendant to move, answer, or otherwise respond to the First Amended Complaint is vacated, and Defendant's December 21, 2010 motion to dismiss the First Amended Complaint pursuant to Rule 12(b)(6) is withdrawn without prejudice as moot;

C. Plaintiffs are granted leave to file their Second Amended Complaint. Plaintiffs' Second Amended Complaint shall have until January 21, 2011 to file their Second Amended Complaint. If filed after the Court's Order on this stipulation, the Second Amended Complaint shall be deemed filed and accepted as of the entry of the Court's Order on this stipulation;

D. The deadline for Defendant to move, answer, or otherwise respond to the Second Amended Complaint shall be stayed pending a final determination in the above referenced ITC proceeding;

E. Within 30 days of a final determination of the ITC proceeding in *In the Matter of Certain Gaming and Entertaining Consoles, Related Software, and Components thereof*, Investigation No. 377-TA-752, and the associated expiration of this stay, the Parties shall confer with each other and contact the Court for purposes of setting a Scheduling Order, which shall include the setting of a new deadline for Defendant to move, answer, or otherwise respond to the Second Amended Complaint.

DATED: January 17, 2011

Presented by,

**REINHART BOERNER VAN DEUREN
S.C.**

MICHAEL BEST & FRIEDRICH LLP

By /s/Scott W. Hansen
Scott W. Hansen
WI State Bar ID No. 1017206
shansen@reinhardtllaw.com
Lynn M. Stathas
WI State Bar ID No. 1003695
lstathas@reinhardtllaw.com
Rebecca Frihart Kennedy
WI State Bar ID No. 1047201
rkennedy@reinhardtllaw.com
1000 North Water Street, Suite 1700
Milwaukee, WI 53202
Telephone: 414-298-1000
Facsimile: 414-298-8097

*Attorneys for Plaintiffs Motorola Mobility Inc.
and General Instrument Corp.*

Of Counsel:

Jesse J. Jenner

By /s/John C. Scheller
J. Donald Best, SBN 1012450
John C. Scheller, SBN 1031247
Christopher C. Davis, SBN 1064764
One South Pickney Street
Suite 700
Madison, WI 53703

*Attorneys for Defendant Microsoft
Corporation*

Of Counsel:

David T. Pritikin
dpritikin@sidley.com
Richard A. Cederoth
rcederoth@sidley.com
Douglas I. Lewis
dilewis@sidley.com
John W. McBride
jmcabri01@sidley.com

Steven Pepe
ROPES & GRAY LLP
1211 Avenue of the Americas
New York, NY 10036
Telephone: 212-596-9000

Norman H. Beamer
Mark D. Rowland
Gabrielle E. Higgins
ROPES & GRAY LLP
1900 University Avenue, 6 th Floor
East Palo Alto, CA 94303
Telephone: 650-617-4000

SIDLEY AUSTIN LLP
One South Dearborn
Chicago, Illinois 60603
(312) 853-7000

T. Andrew Culbert
andycu@microsoft.com
David E. Killough
davkill@microsoft.com
MICROSOFT CORPORATION
1 Microsoft Way
Redmond, Washington 98052
Telephone: 425-703-8865
Facsimile: 425-869-1327

CERTIFICATE OF SERVICE

I hereby certify that on January 17, 2011, I caused true and correct copies of NOTICE OF APPEARANCE to be served on all counsel of record via the ECF System.

/s/ John C. Scheller
John C. Scheller